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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,445	10/21/2003	Burney J. Latiolais JR.	Frank's Int.-101	3726
21897	7590	08/16/2006	EXAMINER	
THE MATTHEWS FIRM 2000 BERING DRIVE SUITE 700 HOUSTON, TX 77057			CHIN, PAUL T	
			ART UNIT	PAPER NUMBER
			3652	

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/690,445

Applicant(s)

LATIOLAIS ET AL.

Examiner

PAUL T. CHIN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 13, 2006, has been entered.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "110" has been used to designate both "nut" (page 12, line 9) and "through-hole" (page 12, line 18). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to because it appears that the reference "65" in figure 6 should be deleted. Note that the reference "24" shows "a collar member". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as

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"amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "split ring metal band having a metal saw tooth" and "positioned within the circumferential groove" and the "second ring ....bonded to the top surface of said shoulder ring" (Claims 4 and 11) must be shown or the feature(s) canceled from the claim(s). None of the figure 12 or figure 21C, shows the structural elements. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The disclosure is objected to because of the following informalities: it appears on page 9, line 14, that the word "Paragraph" before "5" should be changed to -- Figure --, and on page 12, lines 8, 21, and 22, the reference "108" should be changed to -- 109 -- (see Figs. 13A and 13B).

Appropriate correction is required.

6. The disclosure is objected to because of the following informalities: **the provided page 4 (see the attachment) is unreadable and a new page 4 is required to provide.** Appropriate correction is required.

7. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Objections***

8. Claims 4 and 11 are objected to because of the following informalities: it appears that the phrase "of the first cylinder ring --" should be inserted after "sidewall" (claim 4, line 4, and claim 11, line 4) to clearly point out the claim subject matter. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 3,4,10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis for "said circumferential band" (claims 3 and 10). Note that claims 1 and 8 recite "a circumferential groove", not "the circumferential band" as applicant recited. Further, there is no antecedent basis for "the top surface of said shoulder ring" (claim 4 and 11). It is unclear as to how "the lower end of the second ring" is bonded to the top surface of the shoulder ring (not shown).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1,3,8, and 10, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins, III (5,706,894) (see IDS) in view of Williams et al. (2,628,134).

Hawkins, III (5,706,894) discloses a ring device comprising a cylindrical ring (1) sized to slide over the exterior surface of the tubular, said ring having a first end, a second end, and a shoulder ring having upper and lower surfaces at its first end and a sidewall between said second end and said shoulder end, said sidewall having a circumferential

groove (10) about its interior surface, and a second groove (13,13) through said sidewall for accessing said circumferential groove; a split-ring rigid band (2) having first and second ends (see Fig. 2) positioned within said circumferential groove. Hawkins, III (5,706,894) does not show a latch mechanism on the band being connected between said first and second ends of said band, and said latch mechanism having a handle (123) accessible through said second groove which, when activated, reduces the internal diameter of said band. However, Williams et al. (2,628,134) teaches a latch mechanism having a handle (6) to firmly lock the band. Accordingly, it would have been obvious to those skilled in the art to provide a latch mechanism on the band of Hawkins, III (5,706,894) as taught by Williams et al. (2,628,134) to firmly lock the band. With regard to material selection, the split ring band (2) is being made of a rigid material. Hawkins, III (5,706,894) does not show that the band is being made of metal. However, it would have been obvious to those skilled in the art to make the band with a metal or stainless steel on the Hawkins's band (2) to provide reliable strength and prevent corrosion to the device. Note that the modified Hawkins, III (5,706,894) is capable of performing the functional limitations.

13. Claims 4-7 and 11-14, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins, III (5,706,894) and Williams et al. (2,628,134), as applied to claims 1 and 8, and further in view of Stevenson (2,175,414).

The modified Hawkins, III (5,706,894), as presented above, does not show a second split ring to bond to the exterior of the sidewall of the first cylinder ring. However, Stevenson (2,175,414) teaches a split ring (36,37) (see Fig. 4) to wrap to the exterior of the sidewall of a first cylinder ring (35). Accordingly, it would have been obvious to those

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skilled in the art to provide a second split ring over the band of Hawkins, III (5,706,894)

as taught by Stevenson (2,175,414) to further protect the shoulder ring of Hawkins.

Note that Stevenson (2,175,414) shows a split ring having a cu-out portion (see Fig. 5) which can be aligned with the second groove and figure 1 shows a beveled edge. It also would have been obvious to those skilled in the art to make the ring with a non-metal material such as a plastic on the second ring of Stevenson (2,175,414) to prevent corrosion to the device.

### ***Double Patenting***

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 1,3-8, and 10-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/689,913. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the instant application claims are encompassed by the subject matter in the claims of the copending application. Both of the instant application and the copending application recite a cylinder ring having a shoulder ring, a



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sidewall having a circumferential groove, a split metal band having a latch mechanism, the metal band having a saw tooth inner diameter, and a second band to grip the external surface of the tube.

This is a provisional obviousness-type double patenting rejection.

***Response to Arguments***

16. Applicant's arguments with respect to claims 1,3-8, and 10-14 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The European Patent 233972 shows a load ring.

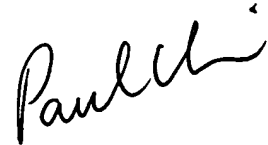
Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL T. CHIN whose telephone number is (571) 272-6922. The examiner can normally be reached on MON-THURS (7:30 -6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EILEEN LILLIS can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PAUL T. CHIN  
Examiner  
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A handwritten signature in black ink, appearing to read "Paul Chin", is written over the printed name and title.

attachment

Exhibit A (from specification)

the box end of the tubular joint 10, then the handle 112 for the latch is rotated away from the end having the nut 110 thereon. The latch is in the open position in FIG. 13a. Closing the handle that way causes the two ends of the band 80 to be brought closer together where the internal diameter of the band is resting upon the tubular joint 10. As seen in FIG.'s 8 and 9-11, as the inclined surface of the band 80 tries to run down the inclined surface 81 of FIG. 8, the band 80 moves against the external surface of the tubular joint 10. The additional weight of the band 80 tends to make the connection tighter and tighter against the external surface

the apparatus shown in FIG. 6 with the band 80 therein, and when the device is turned upside-down and run past the pin end 14 to the box end 12, the band 80 will contact the exterior surface of the tubular joint 10, but the body of the thread protector shown in FIG. 12 will not contact the threads of the pin end 14. Any movement of the tubular joint 10 with respect to the thread protector, only makes the band 80 go tighter against the exterior surface of the tubular joint 10, which prevents the thread protector from separating from the tubular joint 10 and will thus protect the threads of the pin end 14 until the handle 112 is rotated back the other direction to allow the band 80 to fit more loosely against the tubular joint 10, and thus allow the thread protector to be easily removed from the tubular joint 10.

Now referring to FIG. 20, a prior art joint of oilfield tubular 10 such as is illustrated in FIG. 1, and having an upper box end 12 and a lower pin end 14, is illustrated as modified in accordance with the present invention attached near the upper box end of the tubular joint 10, and also having the thread protector in accordance with the